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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/942,345 | 08/29/2001 | Takenori Goto | 11A 3156 | 7101 |

7590 09/08/2004
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EXAMINER

O#CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,345

Applicant(s)

Goto et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Aug 29, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Drawings

1. Figures 5 and 6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e)¹ the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United

¹ The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) apply to the examination of this application as the application being examined was (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) as amended by the AIPA (post-AIPA 35 U.S.C. 102(e)).

States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1, 3, 5, 6, and 8 are rejected under 35 U.S.C. 102 as being anticipated by the admitted prior art, as described in the background of the invention on pages 1-3 of the specification, and as compared to the instant invention in the summary of the invention on pages 4-7 of the specification.

The admitted prior art system comprises a network system that includes an order-placing server for placing an order for parts using an image drawing, and an order receiving server having a log-in step, a retrieval step, a recognition step, and an order-placing step; characterized in that: the order-placing server is comprised of a means for preparing an order-placing page corresponding to an order-placing destination for selected parts, and a means for transmitting the order-placing page to a recognition step of the order-receiving server; and, the order-receiving server is comprised of a means for validating a log-in name included in the order-placing page having been sent to said recognition step, and a means for recognizing parts number included in the order-placing page to retrieve a part information of said parts number from a data base.

Regarding claim 8, the admitted prior art network system includes that the order-receiving server further comprises means for displaying the number of stocks of parts received.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the background of the invention on pages 1-3 of the specification, and as compared to the instant invention in the summary of the invention on pages 4-7 of the specification.

The admitted prior art comprises a network system that includes an order-placing server for placing an order for parts, as applied above in the rejection of claims 1 and 3 under 35 U.S.C. 102, but the admitted prior art comprises merely a single order-receiving server, rather than a plurality of order-receiving servers. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the known network system so as to comprise multiple order-receiving servers, rather than merely a single order-receiving server, and to customize/adjust accordingly the order-placing page being submitted to each of the order-receiving servers to accommodate disparate input requirements of each server, in order to include multiple suppliers in the system, each supplier having their own order-receiving server for receiving orders placed with them, since making such a modification could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, and since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 7, the admitted prior art comprises a network system that includes an order receiving server having a log-in step, a retrieval step, a recognition step, and an order-placing step, as applied above in the rejection of claim 6 under 35 U.S.C. 102, but the disclosure of the known prior art network system does not appear to include that the order-receiving server further comprises means for classifying results obtained by retrieving said parts number into parts immediately deliverable and parts not immediately deliverable, thereby displaying the parts. However, the known system does display stock information of parts. For those of ordinary skill in the art, displaying an indication of the status of parts on hand as to how many of the parts on hand are deliverable and how many are not, is a well known, hence obvious, step to follow. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the known prior art network system so as to have the order-receiving server further comprise means for classifying and displaying results obtained by retrieving said parts number into parts immediately deliverable and parts not immediately deliverable, as is well known to do, in order to provide customers with the true availability of parts on hand, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 9, the admitted prior art network system includes that the order-receiving server further comprises means for displaying the number of stocks of parts received.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to the disclosure.

7. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is **(703) 308-1113**.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(703) 308-5183**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

August 31, 2004

 (8-31-04)

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627